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| 10/602,010 | 06/23/2003 | Bruce Edward Stuckman | 1033-T00531 | 7678 |

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EXAMINER

BASHORE, WILLIAM L

ART UNIT PAPER NUMBER

2176

DATE MAILED: 11/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/602,010

Applicant(s)

STUCKMAN ET AL.

Examiner

William L. Bashore

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>10/20/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: original application filed 6/22/2003, IDS filed 10/20/2003.
2. Claims 1-34 pending. Claims 1, 24 are independent.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Utsumi, Yoshimasa (hereinafter Utsumi), European Patent No. EP 1 160 708 A1, published December 5, 2001.**

In regard to independent claim 1, Utsumi teaches a method of assessing possible patent infringement (Utsumi Abstract, para [0013]) whereby information is posted on a Website seeking possible infringement information regarding a particular patent, etc. (Utsumi para [0023], [0024], [0025]). If a user wishes to input a possible infringement target, he/she can do so via an input form (Utsumi para [0027], [0028], [0029], [0030]).

Utsumi teaches an input form field for inputting detailed infringement information (Utsumi para [0030] window 23). Although Utsumi does not specifically recite "identifying an infringement target", along with a description of how said target meets the criteria, nevertheless, since window 23 is offered for input of infringement target information, and since the size of said window at least suggests the capability of inputting as much information as possible, it would have been obvious to one of ordinary skill in the art at the time of the invention to include multiple (i.e. a first and second, etc.) user input comprising at least the identification of "an

Art Unit: 2176

infringement target”, along with some form of analysis of how the target meets the criteria set forth in the original posting. Doing so provides the benefit of providing as complete and as detailed infringement information as possible, therefore increasing the chances of obtaining a reward.

In regard to dependent claim 2, Utsumi teaches a plurality of input boxes (Utsumi Figure 3). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply said input boxes for inputting portions of a second input, so as to facilitate better organization.

In regard to dependent claim 3, Utsumi teaches a plurality of input boxes (Utsumi Figure 3), suggestion the separation of various information. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply said input boxes for inputting portions of a second input, so as to facilitate better organization.

In regard to dependent claims 4-8, Utsumi teaches a plurality of display portions displaying criteria (Utsumi Figure 2). Since clicking on a link (Utsumi Figure 2 items 13-15) results in the submission window of Figure 3, it would have been obvious to one of ordinary skill in the art at the time of the invention to apply said window adjacent to (i.e. near to, or in columnar fashion etc.) the criteria, providing the benefit of increased organization. Mitsumi’s Figure 3 accepts natural (i.e. English, etc.) language input.

In regard to dependent claims 9-11, Utsumi teaches a Web form (Utsumi para [0027]). Utsumi teaches identification of a product, and a company (Utsumi para [0006], [0028]).

In regard to dependent claim 12, Utsumi teaches a submission judged (evaluated) by a server management company (Utsumi para [00028]).

In regard to dependent claims 13-17, Utsumi teaches judgment by a patent attorney (Utsumi para [0037]). A reward is issued for a first on-point submission accordingly, along with deals, fixed and/or variable fees etc. (Utsumi para [0037] to [0041]).

In regard to dependent claims 18-19, Utsumi teaches submission via e-mail, which contains a date and time stamp. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply a date and time stamp of submission, providing the benefit of timely submissions in case of disputes, etc.

In regard to dependent claims 20-21, Utsumi teaches a suitable network (Utsumi para [0049], Figure 4 item 3). Although an “intranet” is not specifically disclosed, Utsumi does teach said network as the Internet (Utsumi para [0024]), providing reasonable suggestion to one of ordinary skill in the art at the time of the invention to utilize an intranet instead (intranet is contained, while the Internet is global), providing the benefit of increased security for seeking infringement of classified patents, etc.

In regard to dependent claim 22, although Utsumi does not specifically teach “graphical” input, nevertheless, Utsumi teaches nearly any type of communication mechanism for reporting information, including e-mail (Utsumi para [0051]). Since it is well established that e-mail has the capacity of attaching files (i.e. a pdf file, which is an image based document), it would have been obvious to one of ordinary skill in the art at the time of the invention to provide graphical input such as pdf as an e-mail attachment, providing the benefit of allowing a wide range of input from various sources.

In regard to dependent claim 23, Utsumi teaches multiple languages (Utsumi para [0026], Figure 2).

Art Unit: 2176

In regard to independent claim 24, claim 24 reflects the article of manufacture comprising computer readable instructions used for performing the methods as claimed in claim 1, and is rejected along the same rationale.

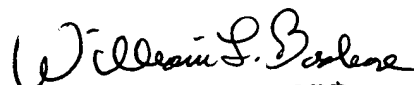
In regard to dependent claims 25-34, claims 25-34 reflect the article of manufacture comprising computer readable instructions used for performing the methods as claimed in claims 2-9, 22-23, respectively, and are rejected along the same rationale.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Bashore whose telephone number is (571) 272-4088. The examiner can normally be reached on 11:30am - 8:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

6. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


WILLIAM BASHORE
PRIMARY EXAMINER

November 13, 2005